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OFFICE OF PETITIONS

In re Application of :
Kozicki et al. : DECISION ON PETITION
Application No. 10/796,808 :
Filed: March 8, 2004 :
Atty Docket No. 29089.4300 :

This is a decision on the "PETITION TO ACCEPT UNINTENTIONALLY DELAYED CLAIM UNDER 35 USC 119(E) FOR BENEFIT OF PRIOR-FILED PROVISIONAL APPLICATION," filed May 25, 2005. Applicants petition for acceptance of the priority claim of the present application to Provisional Application Serial No. 60/452,648.

The petition is **DISMISSED**.

A petition under 37 CFR 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of a prior filed provisional application, is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5), and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the surcharge set forth in 37 CFR 1.17(t);
- (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5) and the date the claim was filed was unintentional; and

(3) the reference to the prior filed provisional application, supplied in an application data sheet (ADS) (37 CFR 1.76) or as an amendment in the first sentence of the specification following the title. See 35 USC 119(e) and 37 CFR 1.78(a)(5). The Director may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application was filed on March 8, 2004, and the claim for priority herein is submitted after expiration of the period specified in 37 CFR 1.78(a)(5). The instant petition includes the required surcharge and the required statement of unintentional delay.

Moreover, the present application was filed on Monday, March 8, 2004, within twelve months¹ of the filing date of the prior provisional application, Application No. 60/452,648, which was filed on March 7, 2003, and for which priority is claimed. A reference to the prior provisional application has been included as an amendment to the first sentence of the specification following the title. However, the amendment is not acceptable.

Under 35 U.S.C. 119(e), as contained in Public Law 103-465, a later filed nonprovisional application under 35 U.S.C. 111(a) that is filed within twelve months of an earlier provisional application may claim priority benefits based on the earlier filed provisional application so long as both applications have at least one inventor in common. The amendment includes claims for benefit of other provisional applications under 35 U.S.C. 119(e). However, the amendment does not make clear that any nonprovisional application in the chain was filed within twelve months from the filing date of those provisional applications. The amendment does not identify the intermediate nonprovisional applications that directly claim the benefit of the provisional application and were filed within 12 months of the filing date of the provisional application. Although an application that itself directly claims the benefit of a provisional application is not required to specify the relationship to the provisional application, if the instant nonprovisional application is not filed within the 12 month period, but claims the benefit of an

¹ 37 CFR 1.7(b) provides that: If the day that is twelve months after the filing date of a provisional application under 35 U.S.C. 111(b) and § 1.53(c) falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the period of pendency shall be extended to the next succeeding secular or business day, which is not a Saturday, Sunday, or a Federal holiday.

Where the benefit of more than one provisional application is being claimed, the intermediate nonprovisional application(s) claiming the benefit of each provisional application must be indicated. Applicant must state, for example, "this application is continuation of Application No. D, filed ---, which is a continuation-in-part of Application No. C, filed ---, Application No. D claims the benefit of provisional Application No. B, filed ---, and Application No. C claims the benefit of provisional Application No. A, filed ---." If a benefit claim to a provisional application is submitted without an indication that an intermediate application directly claims the benefit of the provisional application and the instant nonprovisional application is not filed within the 12 month period or the relationship between each nonprovisional application is not indicated, the Office will not recognize such benefit claim and will not include the benefit claim on the filing receipt.


In view thereof, the petition must be dismissed.

Further correspondence with respect to this decision should be addressed as follows:

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